

**REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed February 27, 2001. In the Office Action, Claims 1-57 were rejected. In order to advance prosecution of the application, Claims 1, 25 and 51 have been amended, and Claims 52 and 55 have been canceled. Thus, Claims 1-51, 53-54 and 56-57 are now pending in this Application. Applicants respectfully request reconsideration and favorable action in this case.

**Section 102 Rejections**

The Examiner rejected pending Claims 1-3, 7, 14-21, 23, 25-27, 31, 36-43, 45 and 47-50 under 35 U.S.C. §102(b) as being anticipated by European Patent No. 0 511 463 A2 issued to Greer (*Greer*). Of these, Claims 1 and 25 are independent. Applicants respectfully traverse these rejections for the reasons discussed below.

The Examiner has not addressed previous amendments to independent Claims 1 and 25, which resulted in those claims positively reciting that the discount triggering items are associated with a pre-determined redeemable item. Because *Greer* fails to disclose this element of the independent claims, *Greer's* system benefits only two entities: the store and the manufacturer of the specific product. Col. 9, lines 1-28. In contrast, the present invention provides for discount triggering items to be associated with a pre-determined redeemable item, resulting in an advantage over *Greer* because a customer is given incentive to purchase multiple products at multiple locations. Thus, the present invention benefits four different entities: the initial vendor, the subsequent vendor, and the manufacturers of both the discount triggering items and the pre-determined redeemable item.

In the final Office Action, the Examiner interpreted the initial vendor and the subsequent vendor as being the same vendor. Office Action, page 6. Thus, Claim 1 has been amended to positively recite "the subsequent vendor distinct from the initial vendor." *Greer* teaches away from this element by disclosing that an advantage of its system is that "large numbers of customers are involved and given incentive to return to the store." Col. 9, lines 17-19 (emphasis added). Thus, *Greer* cannot be modified as suggested by the Examiner, as any such modification would destroy the functionality of the system by eliminating the stated advantage of giving a customer incentive to return to the same store to redeem the certificate. Accordingly, for at least this reason, Claim 1, as amended, is allowable over the cited art. Therefore, Applicants respectfully submit that this rejection should now be withdrawn.

Similar to Claim 1, independent Claim 25, as amended, recites "identifying means for identifying discount triggering items in an initial purchase transaction at an initial vendor, the discount triggering items associated with a pre-determined redeemable item," "output means for generating the redemption value for the pre-determined redeemable item based on the bundle totals, the redemption value representing a discount available for use in a subsequent purchase transaction at a subsequent vendor, the subsequent vendor distinct from the initial vendor, the subsequent purchase transaction comprising the pre-determined redeemable item." Accordingly, for the reasons discussed above in connection with Claim 1, Claim 25, as amended, is also not anticipated by the cited art. Therefore, Applicants respectfully submit that this rejection should now be withdrawn.

Dependent Claims 2, 3, 7, 14-21, 23, 47 and 48 that depend from independent Claim 1 and dependent Claims 26, 27, 31, 36-43, 45, 49 and 50 that depend from independent Claim 25 are also not anticipated by the cited art because they include the limitations of their respective base claims and add additional elements that further distinguish the art. Therefore, Applicants respectfully submit that these rejections should now be withdrawn.

**Section 103 Rejections**

The Examiner rejected pending Claims 4-6, 8-13, 22, 24, 28-30, 32-35, 44, 46 and 51-57 under 35 U.S.C. §103(a). Of these, Claim 51 is independent. Claims 52 and 55 have been canceled. Applicants respectfully traverse these rejections for the reasons discussed below.

Claims 4-6, 8-13, 22, 24 and 53-54 depend from independent Claim 1, and Claims 28-30, 32-35, 44, 46 and 56-57 depend from independent Claim 25. As discussed above in connection with the § 102 rejections, Claims 1 and 25 are patentable over the cited art. Therefore, Claims 4-6, 8-13, 22, 24, 28-30, 32-35, 44, 46, 53-54 and 56-57 are patentable over the art because they include the elements of their respective base claims and add additional elements that further distinguish the art.

Similar to Claim 1, independent Claim 51, as amended, recites “identifying credit triggering items in an initial purchase transaction at an initial vendor, the discount triggering items associated with a pre-determined redeemable item,” “generating the redemption value for the pre-determined redeemable item based on the bundle totals, the redemption value representing a credit available for use in a subsequent purchase transaction at a subsequent vendor, the subsequent vendor distinct from the initial vendor, the subsequent purchase transaction comprising the pre-determined redeemable item.” Accordingly, for the reasons discussed above in connection with Claim 1, Claim 51, as amended, is patentable over the cited art. Therefore, Applicants respectfully submit that this rejection should now be withdrawn.

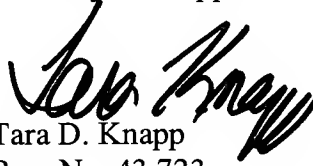
**CONCLUSION**

Applicants have now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorneys for Applicants

  
Tara D. Knapp  
Reg. No. 43,723

2001 Ross Avenue, Suite 600  
Dallas, Texas 75201-2980  
(214) 953-6910  
Date: Aug 24, 2001

Enclosures: Notification of Extension of Time Under 37 C.F.R. § 1.136;  
\$445.00 Check for Extension of Time; and  
Marked-up copy of claims showing amendments (\_\_\_ sheets)



**MARKED-UP COPY OF CLAIMS SHOWING AMENDMENTS**

1. **(Four Times Amended)** A method for generating a redemption value for at least one pre-determined redeemable item, comprising the steps of:

identifying discount triggering items in an initial purchase transaction at an initial vendor, the discount triggering items associated with a pre-determined redeemable item, each of the discount triggering items having a unique code **and a manufacturer** associated therewith and an associated discount value;

grouping the discount triggering items in bundles, each bundle comprising one or more discount triggering items having the same unique code **and the same manufacturer**, each bundle having an associated bundle total; **[and]**

generating the redemption value for the pre-determined redeemable item based on the bundle totals, the redemption value representing a discount available for use in a subsequent purchase transaction at a subsequent vendor, **the subsequent vendor distinct from the initial vendor**, the subsequent purchase transaction comprising the pre-determined redeemable item[.];

**providing the discount in the subsequent purchase transaction at the subsequent vendor; and**

**receiving a reimbursement for the discount from each manufacturer of the discount triggering items at the subsequent vendor, the reimbursement for each manufacturer based on the bundle totals associated with the bundles comprising the discount triggering items for the manufacturer.**

2. **(Previously Amended)** The method of Claim 1, wherein the step of grouping the discount triggering items in bundles is performed at the end of the initial purchase transaction.

3. **(Previously Amended)** The method of Claim 1, wherein the step of grouping further comprises the step of filtering in accordance with predetermined criteria the discount triggering items to be included in the bundle.

4. **(Previously Amended)** The method of Claim 3, wherein the step of filtering in accordance with the predetermined criteria comprises filtering the discount triggering items such that if the quantity of discount triggering items purchased is less than a predetermined minimum quantity for each of the unique codes, the bundle is not created.
5. **(Previously Amended)** The method of Claim 3, wherein the step of filtering in accordance with the predetermined criteria comprises limiting the number of discount triggering items in any one of the bundles to a maximum number.
6. **(Previously Amended)** The method of Claim 47, generating the redemption value for the pre-determined redeemable item further comprising limiting the redemption value to a maximum value.
7. **(Previously Amended)** The method of Claim 1, the initial purchase transaction comprising a plurality of purchased items, the purchased items comprising the discount triggering items and non-discount triggering items, and further comprising the step of issuing cash register receipt information reflecting the retail price of each of the purchased items.
8. **(Previously Amended)** The method of Claim 1, the initial purchase transaction comprising a plurality of purchased items, the purchased items comprising the discount triggering items and non-discount triggering items, and further comprising the step of printing a paper receipt comprising cash register receipt information and redemption information, the cash register receipt information reflecting the retail price of each of the purchased items and the redemption information comprising the redemption value and, for each bundle, the unique code associated with the discount triggering items in the bundle and the associated bundle total.
9. **(Previously Amended)** The method of Claim 8, wherein the step of printing the paper receipt comprises the step of providing an incomplete cut between a portion of the paper receipt comprising the cash register receipt information and a portion of the paper

receipt comprising the redemption information, such that the portion comprising the redemption information is easily detachable from the portion comprising the cash register receipt information.

10. **(Previously Amended)** The method of Claim 7, wherein the step of issuing the cash register receipt information comprises the step of providing an electronic code comprising the cash register receipt information.

11. The method of Claim 10, wherein the electronic code is recordable on a card having magnetic media.

12. **(Previously Amended)** The method of Claim 48, wherein the step of providing the redemption information comprises the step of providing an electronic code comprising the redemption information.

13. The method of Claim 12, wherein the electronic code is recordable on a card having magnetic media.

14. **(Previously Amended)** The method of Claim 1, the initial purchase transaction comprising a plurality of purchased items, the purchased items comprising the discount triggering items and non-discount triggering items, the non-discount triggering items having a unique code associated therewith, and wherein the step of identifying discount triggering items comprises the steps of:

receiving the unique code for each of the purchased items; and

determining which of the purchased items has a unique code associated with a discount triggering item.

15. **(Previously Amended)** The method of Claim 14, further comprising the step of providing a database having stored therein information identifying the discount triggering items and the associated unique codes, and wherein the step of determining which of the

purchased items has a unique code associated with a discount triggering item comprises comparing each of the received unique codes with the information in the database.

16. **(Previously Amended)** The method of Claim 14, receiving the unique code for each of the purchased items comprising scanning the unique codes with a scanning device.

17. **(Previously Amended)** The method of Claim 14, receiving the unique code for each of the purchased items comprising inputting the unique codes manually.

18. **(Previously Amended)** The method of Claim 48, wherein the step of providing the redemption information comprises providing a description for each of the bundles, which description is associated with the unique code for the bundle.

19. **(Previously Amended)** The method of Claim 48, further comprising the steps of printing the redemption information on a paper slip and digitally encoding the redemption information on the paper slip, the digitally encoded redemption information optically retrievable.

20. **(Previously Amended)** The method of Claim 19, wherein the digitally encoded redemption information comprises a bar code.

21. **Previously Amended)** The method of Claim 48, wherein each transaction has associated therewith a unique identification number (UID) and further comprising the step of printing the UID for the transaction on a paper containing the redemption information.

22. **(Previously Amended)** The method of Claim 1, the initial purchase transaction comprising a plurality of purchased items, the purchased items comprising the discount triggering items and non-discount triggering items, and wherein a product information table is provided for all items having a unique code and further comprising the step of creating a redemption table providing additional parameters associated with discount



triggering items defining the ones of the items in the product information table as discount triggering items and also further comprising the step of creating a modified product information table by merging the redemption table with the product information table such that each unique code has associated therewith information regarding the identification of a product having that unique code, and that constitutes a discount triggering item, and wherein the step of identifying comprises comparing each of the purchased items and the associated unique code with information in the modified product information table, and when the unique code in the modified product information table has information associated therewith, defining it as a discount triggering item, and declaring that item a discount triggering item.

23. **(Previously Amended)** The method of Claim 48, further comprising the step of purchasing the pre-determined redeemable item in the subsequent purchase transaction by presenting a paper comprising the redemption information.

24. **(Previously Amended)** The method of Claim 48, wherein the pre-determined redeemable item is obtained by presenting electronic code comprising the redemption information.

25. **(Four Times Amended)** A system for generating a redemption value for at least one pre-determined redeemable item, comprising:

identifying means for identifying discount triggering items in an initial purchase transaction at an initial vendor, the discount triggering items associated with a pre-determined redeemable item, each of the discount triggering items having a unique code and a manufacturer associated therewith and an associated discount value;

grouping means for grouping the discount triggering items in bundles, each bundle comprising one or more discount triggering items having the same unique code and the same manufacturer, each bundle having an associated bundle total; [and]

output means for generating the redemption value for the pre-determined redeemable item based on the bundle totals, the redemption value representing a discount available for use in a subsequent purchase transaction at a subsequent vendor, the

subsequent vendor distinct from the initial vendor, the subsequent purchase transaction comprising the pre-determined redeemable item[.];

means for providing the discount in the subsequent purchase transaction at the subsequent vendor; and

means for receiving a reimbursement for the discount from each manufacturer of the discount triggering items at the subsequent vendor, the reimbursement for each manufacturer based on the bundle totals associated with the bundles comprising the discount triggering items for the manufacturer.

26. **(Previously Amended)** The system of Claim 25, wherein the bundles are created at the end of the initial purchase transaction.

27. **(Previously Amended)** The system of Claim 25, wherein the grouping means further comprises a filtering means for filtering, in accordance with predetermined criteria, the discount triggering items to be included in the bundle.

28. **(Previously Amended)** The system of Claim 27, wherein the bundle is created only if the quantity of discount triggering items purchased is equal to or greater than a predetermined minimum quantity for each of the unique codes.

29. **(Previously Amended)** The system of Claim 27, wherein the number of discount triggering items in any one of the bundles is limited to maximum number.

30. **(Previously Amended)** The system of Claim 49, the output means for limiting the redemption value to a maximum value.

31. **(Previously Amended)** The system of Claim 25, the initial purchase transaction comprising a plurality of purchased items, the purchased items comprising the discount triggering items and non-discount triggering items, and further comprising output means for issuing cash register receipt information reflecting the retail price of each of the purchased items.

32. **(Previously Amended)** The system of Claim 31, wherein both the cash register receipt information and redemption information are issued on a paper receipt, the redemption information comprising the redemption value and, for each bundle, the unique code associated with the discount triggering items in the bundle and the associated bundle total.

33. **(Previously Amended)** The system of Claim 32, wherein the paper receipt comprises an incomplete cut between a portion comprising the cash register receipt information and a paper portion comprising the redemption information, such that the portion comprising the redemption information is easily detachable from the portion comprising the cash register receipt information.

34. **(Previously Amended)** The system of Claim 31, the output means for providing redemption information and the cash register receipt information in the form of an electronic code, the redemption information comprising the redemption value and, for each bundle, the unique code associated with the discount triggering items in the bundle and the associated bundle total.

35. The system of Claim 34, wherein the electronic code is recordable on a card having magnetic media.

36. **(Previously Amended)** The system of Claim 25, the initial purchase transaction comprising a plurality of purchased items, the purchased items comprising the discount triggering items and non-discount triggering items, the non-discount triggering items having a unique code associated therewith, and wherein the identifying means comprises:

a receiving means for receiving the unique code for each of the purchased items; and

a determining means for determining which of the purchased items has a unique code associated with a discount triggering item.

37. **(Previously Amended)** The system of Claim 36, further comprising a database having stored therein information identifying the discount triggering items and the associated unique codes, the determining means for comparing the unique codes of the purchased items with the information in the database in order to determine which of the purchased items are discount triggering items.

38. **(Previously Amended)** The system of Claim 37, wherein the unique codes are all scannable by a scanning device.

39. **(Previously Amended)** The system of Claim 37, wherein the unique codes are input manually.

40. **(Previously Amended)** The system of Claim 50, wherein the redemption information comprises a description for each of the bundles, which description is associated with the unique code for the bundle.

41. **(Previously Amended)** The system of Claim 50, wherein the redemption information is printed on a paper slip with a digitally encoded region disposed thereon, the digitally encoded region comprising information regarding the information contained within the paper slip, the digitally encoded information optically retrievable.

42. The system of Claim 41, wherein the digitally encoded region comprises a bar code.

43. **(Previously Amended)** The system of Claim 50, wherein each transaction has associated therewith a unique identification number which is printed on a paper containing the redemption information.

44. **(Previously Amended)** The system of Claim 25, the initial purchase transaction comprising a plurality of purchased items, the purchased items comprising the discount triggering items and non-discount triggering items, and wherein a product information table is provided for all items having a unique code, a redemption table is provided for additional parameters associated with discount triggering items defining the ones of the items in the product information table as discount triggering items, a modified product information table is provided by merging the redemption table with the product information table such that each unique code has associated therewith information regarding the identification of a product having that unique code and that constitutes a discount triggering item, and wherein each of the purchased items and the associated unique code are compared with information in the modified product information table and when the unique code in the modified product information table has information associated therewith defining it as a discount triggering item and declaring that item a discount triggering item.

45. **(Previously Amended)** The system of Claim 50, wherein the pre-determined redeemable item is purchased in the subsequent purchase transaction by presenting a paper comprising the redemption information.

46. **(Previously Amended)** The system of Claim 50, wherein the pre-determined redeemable item is obtained by presenting electronic code comprising the redemption information.

47. **(Previously Amended)** The method of Claim 1, generating the redemption value for the pre-determined redeemable item based on the bundle totals comprising summing the bundle totals.

48. The method of Claim 1, further comprising the step of providing redemption information comprising the redemption value and, for each bundle, the unique code associated with the discount triggering items in the bundle and the associated bundle total.

49. The system of Claim 25, the output means for generating the redemption value by summing the bundle totals.

50. The system of Claim 25, the output means for providing redemption information comprising the redemption value and, for each bundle, the unique code associated with the discount triggering items in the bundle and the associated bundle total.

51. **(Twice Amended)** A method for generating a redemption value for at least one pre-determined redeemable item, comprising the steps of:

identifying credit triggering items in an initial purchase transaction at an initial vendor, the discount triggering items associated with a pre-determined redeemable item, each of the credit triggering items having a unique code and a manufacturer associated therewith and an associated credit value;

grouping the credit triggering items in bundles, each bundle comprising one or more credit triggering items having the same unique code and the same manufacturer, each bundle having an associated bundle total; **[and]**

generating the redemption value for the pre-determined redeemable item based on the bundle totals, the redemption value representing a credit available for use in a subsequent purchase transaction at a subsequent vendor, the subsequent vendor distinct from the initial vendor, the subsequent purchase transaction comprising the pre-determined redeemable item[.];

providing the credit in the subsequent purchase transaction at the subsequent vendor; and

receiving a reimbursement for the credit from each manufacturer of the credit triggering items at the subsequent vendor, the reimbursement for each manufacturer based on the bundle totals associated with the bundles comprising the credit triggering items for the manufacturer.

52. **Please cancel Claim 52 without prejudice or disclaimer.**

53. The method of Claim 1, the initial vendor comprising a grocery store and the subsequent vendor comprising a gas station.

54. The method of Claim 1, the pre-determined redeemable item comprising fuel.

55. **Please cancel Claim 55 without prejudice or disclaimer.**

56. The system of Claim 25, the initial vendor comprising a grocery store and the subsequent vendor comprising a gas station.

57. The system of Claim 25, the pre-determined redeemable item comprising fuel.